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DOCKET NO. IZ-200308-001 (SAMS04-08001)

U.S. SERIAL NO. 10/693,089

PATENT

REMARKS

Claims 1-20 are pending in the application.

Claims 1-20 have been rejected.

Claims 1, 5, 8, 11, 15 and 18 have been amended as shown above. Because these amendments place the claims in better condition for allowance or appeal, these amendments comply with 37 C.F.R. § 1.116.

Reconsideration and full allowance of Claims 1-20, as amended, is respectfully requested.

Claim Rejections under 35 U.S.C. § 102

The Office Action mailed November 3, 2006, finally rejects Claims 1-5, 7-11 and 14 as anticipated by Krauss (US6,086,126, hereinafter "Krauss"). The Applicant respectfully traverses the rejection.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP §2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. MPEP §2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

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The Applicants respectfully direct the Examiner's attention to amended independent Claim 1,

which recites the unique and non-obvious limitations emphasized below:

A tool for lifting a pad, comprising:

a non-pivoted jaw structure having an upper jaw portion and a lower jaw portion, the lower jaw portion having outer and inner surfaces, wherein the inner surface is substantially flat and not parallel to the outer surface, the inner surface being operable to receive a portion of the pad;

a first member pivotally coupled to the non-pivoted jaw structure; and

a second member pivotally coupled to the first member, the second member having a surface opposite to the inner surface of the lower jaw portion and operable for clamping the portion of the pad against the inner surface when the first member is pivoted upwards. (*Emphasis added*).

The Applicant respectfully asserts that the above-emphasized limitations are not disclosed in the Krauss reference.

Krauss describes a gripper body 12, including side plate 16 in which a gripping slot 20 is formed. See Krauss, col. 3, lines 43-48, and col. 3, line 61, through col. 4, line 2. The gripping slot 20 includes edges 20a and 20b, slot end 20c and slot wall 20d. See Krauss, col. 4, lines 2-57. In operation, a circuit board may be inserted into gripper slot 20 and clamped against slot wall 20d by clamping element 26. Figure 4 of Krauss, illustrating the gripper body 20 and its components, is reproduced below:

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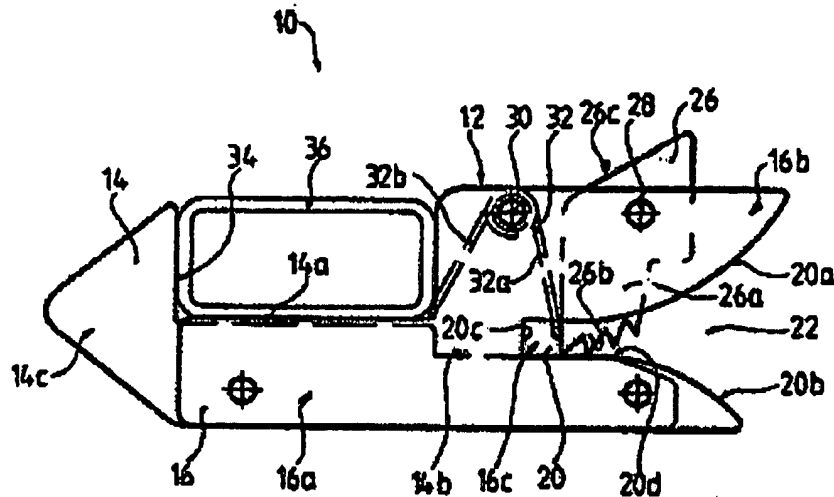


Fig.1

As may be seen from Figure 1, edges 20a and 20b of gripper slot 20 are curved and slot wall 20d is parallel to the lower edge of side plate 16. In contrast, amended Claim 1 recites a jaw structure having a lower jaw portion with a substantially flat inner surface that is not parallel to an outer surface. As such, the Krauss reference fails to teach each and every limitation of the Applicant's invention as recited in Claim 1.

For these reasons, amended independent Claim 1 presents patentable subject matter not taught or suggested by Krauss. Amended independent Claim 8 recites analogous limitations to those recited in Claim 1 and therefore also presents patentable subject matter not taught or suggested by Krauss. Additionally, Claims 2-5 and 7, which depend from Claim 1, and Claims 9-11 and 14, which depend from Claim 8, contain all of the unique and novel limitations recited in their respective base claims. As such, Claims 2-5, 7, 9-11 and 14 are also patentable over Krauss.

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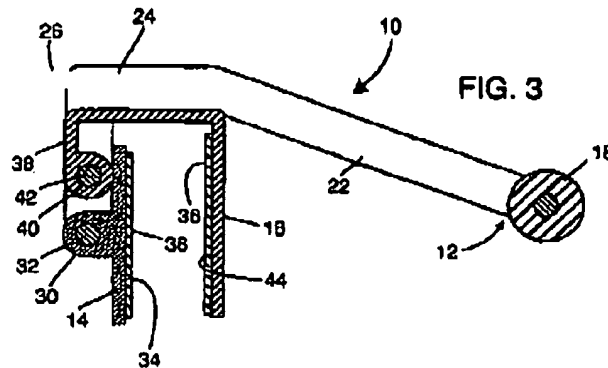
Claim Rejections Under 35 U.S.C. § 103 (a)

The final Office Action of November 3, 2006, rejected Claims 1-20 under 35 U.S.C. § 103(a) as being unpatentable over Worthington in view of Krauss. The Applicant respectfully traverses the rejection.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142, p. 2100-125 (8th ed. rev. 5, August 2006). Absent such a *prima facie* case, the applicant is under no obligation to produce evidence of nonobviousness. *Id.* To establish a *prima facie* case of obviousness, three basic criteria must be met: *Id.* First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *Id.* Second, there must be a reasonable expectation of success. *Id.* Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *Id.* The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *Id.*

The Office Action asserts that Worthington's U-shaped bracket 16, extension 38, and cushion insert 36, describe the recited limitations of a non-pivoted jaw structure, an upper jaw portion, and a lower jaw portion, respectively. Figure 3 of Worthington is reproduced below:

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As may be seen in Figure 3, cushion insert 36, on one side of an unnumbered extension of U-shaped bracket 16, is parallel to the opposite face of that extension. Assuming, without admitting, that the unnumbered extension of U-shaped bracket 16 teaches a lower jaw portion of a jaw structure and cushion insert 36 teaches an inner surface of the lower jaw portion, it is clear from Figure 3 that the outer surface of the lower jaw portion is parallel to the inner surface. Furthermore, there is no teaching elsewhere in the Worthington specification of any other configuration of the U-shaped bracket. In contrast, amended Claim 1 recites a jaw structure having a lower jaw portion with non-parallel inner and outer surfaces. As such, the Worthington reference fails to teach or suggest all the limitations of the Applicant's invention as recited in Claim 1.

As described with regard to the 102 rejection of Claims 1-5, 7-11 and 14, Krauss fails to overcome this shortcoming of Worthington. As Worthington and Krauss fail to teach or suggest the claim limitations, the combination of these references similarly fails to teach or suggest the claim limitations. This being the case, Claims 1-14 are patentable over Worthington and Krauss, individually or in combination.

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Amended independent Claim 15 recites limitations that are analogous to the unique and novel limitations recited in amended independent Claims 1 and 8. This being the case, Claim 15 is patentable over Worthington, Krauss, or the combination of Worthington and Krauss. Dependent Claims 16-20, which depend from Claim 15, contain all of the unique and novel limitations recited in independent Claim 15. Thus, Claims 16-20 also are patentable over Worthington and Krauss.

The Applicant denies any statement, position or averment of the Examiner that is not specifically addressed by the foregoing argument and response. The Applicant reserves the right to submit further arguments in support of his above stated position as well as the right to introduce relevant secondary considerations including long-felt but unresolved needs in the industry, failed attempts by others to invent the invention, and the like, should that become necessary.

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SUMMARY

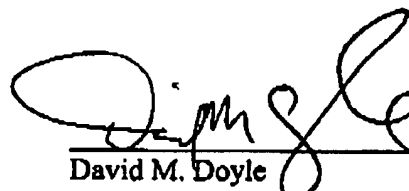
If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at ddoyle@munckbutrus.com.

The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any extension of time fees) or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

MUNCK BUTRUS, P.C.

Date: January 3, 2007



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